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PATENT

IBM/116 10/28/02
Confirmation No. 9216

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cary Lee Bates et al. Art Unit: 2641

Serial No.: 09/491,902 Examiner: Daniel Demelash Abebe

Filed: January 27, 2000 Atty. Docket No.: IBM/116

For: AUTOMATED DETECTION OF SPOKEN NUMBERS IN VOICE
MESSAGES

RESPONSE

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This paper is submitted in reply to the Final Office Action dated July 26,
2002, within the three-month period for response (as October 26, 2002 falls on a
Saturday). Moreover, while this Office Action was initially made final, it is Applicants'
understanding that the finality of this Office Action was withdrawn by the Examiner
pursuant to a telephonic interview with Applicants' representative on July 31, 2002.

As Applicants noted in the aforementioned interview, at least some of the
claims were rejected on the basis of a new reference. For example, claim 1, which
incorporated the original subject matter of claim 7, was rejected on the basis of a new
reference. Moreover, Applicants traversed the rejection of original claim 7 on the basis
that the Dunn et al. reference that was previously applied against the claim was not
properly citeable under 35 U.S.C. § 103(c). It is Applicants' understanding from MPEP
706.02(I)(3) that when a reference is disqualified under this section and the claims are not
amended, the Examiner may not make the next Office Action final if a new rejection is
made. Accordingly, withdrawal of the finality of the previous Office Action, and
consideration of the remarks presented below are respectfully requested.

In the subject Office Action, claims 1-6, 8-9, 13-16, 18-21 and 25-26 were
rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,504,805 to

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Lee. In addition, claims 10-11, 22-23 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,651,056 to Eting et al.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained.

Turning first to the rejections based upon Lee, and in particular, to the rejection of independent claim 1, this claim recites a method of processing a voice message which includes, *inter alia*, "determining a playback start position based upon the position of [a detected] spoken number" and "playing the voice message starting at the playback start position."

Claim 1 stands rejected upon Lee; however, contrary to the Examiner's contention, Lee does not disclose each and every feature of claim 1. In particular, Lee fails to disclose the determination of a playback start position for a voice message based upon the position of a detected spoken number therein, and playing the voice message starting at the playback start position. Indeed, Fig. 6 of Lee, which discloses a routine for playing back a message, does not disclose any mechanism for controlling the playback start position of a message, much less basing such a position upon the detected position of a spoken number in the voice message.

In rejecting claim 1, the Examiner relies principally upon column 2, lines 12-52 of Lee. Of note, however, the Examiner does not even assert in the rejection that Lee discloses controlling a playback position for a voice message based upon the position of a spoken number. Instead, the Examiner relies on column 2, lines 35-38 to supposedly disclose playing an extracted telephone number. Disclosure of playing an extracted number, however, falls short of anticipating claim 1, as there is not even an assertion by the Examiner that Lee discloses <u>controlling a playback start position</u> for any reason, much less based upon the detected position of a spoken number.

Given that Lee does not disclose the control of a playback start position based upon the detected position of a spoken number, Applicants respectfully submit that claim 1 is novel over Lee.

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Moreover, claim 1 is non-obvious over Lee, as there is no suggestion in the reference of the desirability of starting the playback of a voice message at a particular point in a message, much less at a position that is tied to the detected position of a spoken number. As is discussed at length in Applicants' Specification, one advantage of Applicants' claimed invention is that a user listening to a replayed voice message may be able to start the playback of a voice message at a position that is based upon the position of a spoken number, e.g., a few seconds prior to the beginning of the spoken number. By doing so, a user may quickly ascertain the spoken number without having to listen to an entire message. This claimed feature therefore provides a unique and unexpected advantage over prior art voice message playback systems where a user may be required to listen to a significant portion of a voice message to hear a spoken number incorporated into that message.

This feature is not suggested by Lee or any of the other prior art of record. Accordingly, Applicants respectfully submit that claim 1 is also non-obvious over Lee and the other references cited by the Examiner. Reconsideration and allowance of claim 1, as well as of claims 2-6 and 8-9 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claim 13, this claim similarly recites the detection of a position of a spoken number in a textual representation of a voice message, coupled with the determination of a playback start position based upon the position of a spoken number, and the playback of a voice message starting at the playback start position. As discussed above in connection with claim 1, this combination of features is not disclosed or suggested by Lee or any of the other prior art of record. Moreover, claim 13 additionally recites the concept of receiving user input to find a next number from a current playback position in the voice message, and detecting the position of a spoken number by detecting an immediately succeeding spoken number from the current playback position. As such, this additional feature permits a user to skip forward to a

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next spoken number without having to listen to intermediate portions of a message between the current playback position and the start of the succeeding spoken number.

In rejecting claim 13, the Examiner relies generally on Figs. 1, 2 and 6 of Lee. However, the Examiner points to no specific disclosure in the reference regarding this particular feature. The Examiner's rejection is conclusory in nature and insufficient to sustain a rejection based upon the anticipation. Applicants respectfully submit that absent any specific disclosure in Lee as to a manner of detecting the position of a spoken number by detecting an immediately succeeding spoken number from a current playback position, the rejection cannot be sustained. Accordingly, Applicants respectfully submit that claim 13 is novel and non-obvious over the prior art of record. Reconsideration and allowance of claim 13, as well as of claims 14-16 and 18-21 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claim 25, this claim recites *inter alia*, a program configured to detect a position of a spoken number in a textual representation of a voice message, to determine a playback start position based upon the position of a spoken number, and to play the voice message starting at the playback start position. As discussed above in connection with independent claim 1, this combination of features is not disclosed or suggested by Lee. Accordingly, claim 25 is novel and non-obvious over the prior art of record for the same reason as presented above for claim 1. Reconsideration and allowance of claim 25, as well as of claim 26 which depends therefrom, are therefore respectfully requested.

Next, with respect to the rejections based upon Eting et al., and in particular to the rejection of independent claim 10, this claim recites a method of processing a voice message which includes *inter alia* determining that a spoken number is a telephone number. As Applicants noted in the previous Amendment and Response, Eting et al. does not disclose or suggest the automated determination or detection of whether a spoken number is or is not a telephone number. Claim 10 is therefore patentable over Eting et al.

What Eting et al. does disclose, e.g., in Figs. 5 and 7, and the text accompanying the same, is the detection of individual digits, which are then combined to form a recognized number. However, while Eting et al. discloses the detection of numbers formed by strings of digits in a voice message, it is important to note that this detection does not verify whether any particular string of digits forming a number is or is not a valid <u>telephone</u> number. It should be evident, for example, that were the Eting et al. system used to process a voice message that included a spoken number that was <u>not</u> a telephone number, that number would still be stored as a recognized number, irrespective of the fact that the spoken number was not a telephone number. For example, if a voice message included the spoken phrase "my address is 349 Main Street," the Eting et al. system would store the digits "349" as a recognized number. Moreover, a user would be able to automatically dial that number, resulting in the automated dialing of an incorrect number.

The invention set forth in claim 10, on the other hand, permits detected numbers to be verified as telephone numbers, and thus potentially avoids the storage and/or automated dialing of numbers that are not valid telephone numbers. As discussed at page 19, lines 1-7 of the Application, for example, such a determination may be made based upon a number of different factors, e.g., the number of digits, the number format, the presence in a telephone directory service, etc. This configuration provides a unique and unexpected advantage that is simply not disclosed or suggested in Eting et al. or any of the other prior art of record.

In rejecting claim 10, the Examiner relies on column 14, lines 18-35 of Eting et al. for allegedly disclosing confirming a detected telephone number. The cited passage, however, merely discloses the detection of individual digits and storing of those digits as a recognized number. The passage is silent, however, as to any determination of whether any string of spoken digits conforms to a <u>telephone</u> number. Moreover, the Examiner's response to Applicants' arguments relies only on Fig. 4, element 550 for allegedly teaching that messages other than telephone numbers are stored separately in a voice
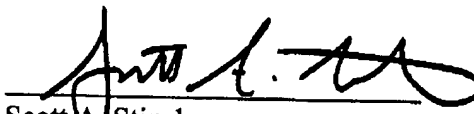
message map. The Examiner has still failed to point to any disclosure in the reference as to any particular logic in Eting et al. that confirms whether a string of digits is or is not a telephone number. Applicants therefore respectfully submit that Eting et al. falls far short of anticipating claim 10. Moreover, as there is no suggestion of the desirability of confirming whether a string of digits is or is not a telephone number, Applicants also respectfully submit that claim 10 is also non-obvious over Eting et al. Reconsideration and allowance of claim 10, as well as of claim 11 which depends therefrom, are therefore respectfully requested.

Next, with regard to independent claims 22 and 27, each of these claims likewise recites the detection of whether a spoken number is a telephone number. As discussed above in connection with claim 10, this feature is not disclosed or suggested by Eting et al. or any of the other prior art of record. Reconsideration and allowance of claims 22 and 27, as well as of claims 23 which depends therefrom, are respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

28 OCT 2002
Date

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PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR COMPETITION LAW
AND RELATED LITIGATION

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October 28, 2002

FACSIMILE COVER SHEET

To: Examiner Daniel Demelash Abebe
        Assistant Commissioner for Patents
        Washington, D.C. 20231

Fax: 703-872-9314

Enclosures:
        Fax Cover Sheet containing Certificate
            of Facsimile Transmission
        Transmittal (in duplicate) containing
            Certificate of Facsimile
            Transmission

From: Scott A. Stinebruner
        Reg. No. 38,323

Re: U.S. Patent Application
        Serial No.   09/491,902
        Filed: January 27, 2000
        Applicant: Cary Lee Bates et al.
        Art Unit: 2641
        Confirmation No.:   9216
        Our Ref: IBM/116

Pages: 11 (including cover sheet)

MESSAGE/COMMENTS
OFFICIAL

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and the enclosures noted herein (11 total pages) are being transmitted via facsimile transmission to Examiner Daniel Demelash Abebe, Assistant Commissioner for Patents, Washington, D.C. 20231 at 703-872-9314 on October 28, 2002.

Judith L. Volk   _October 28, 2002_
        Judith L. Volk   Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Cary Lee Bates et al.	Art Unit:	2641
Serial No.:	09/491,902	Examiner:	Daniel Demelash Abebe
Filed :	January 27, 2000		
For :	AUTOMATED DETECTION OF SPOKEN NUMBERS IN VOICE MESSAGES		

NON-FEE AMENDMENT
Assistant Commissioner for Patents
Washington, DC 20231

AMENDMENT TRANSMITTAL

1. ☒ **Transmitted herewith is a Response.**

2. ☐ Small Entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

   ☐ Enclosed is a verified statement to establish Small Entity status

   ☒ **Other than a Small Entity**

3. **The fee has been calculated as shown below:**

CALCULATION OF FEES

Fee:	Number of Claims After Amendment:		Previously Paid For:	No. Extra:	At Rate:	Amount:
Total Claims	23	minus	27	0	$18	$0.00
Independent Claims	6	minus	6	0	$84	$0.00
MULTIPLE DEPENDENT CLAIM FEE					$280	$0.00
TOTAL FEE FOR CLAIMS:						$0.00

☒ **No additional fee for claims is required.**

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4. ☐ Attached is a check in the sum of $_____ for additional claims.
    ☐ Please charge my Deposit Account No. 23-3000 in the amount of $____.

5. **The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply. Complete (a) or (b) as applicable.**

    ☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

	Ext. Mos.	Large entity	Small entity
☐	one month	$ 110.00	$ 55.00
☐	two months	$ 400.00	$ 200.00
☐	three months	$ 920.00	$ 460.00
☐	four months	$1,440.00	$ 720.00
☐	five months	$1,960.00	$ 980.00

Extension fee due with this request: $_____

Method of Payment: Check enclosed in the amount of $_____

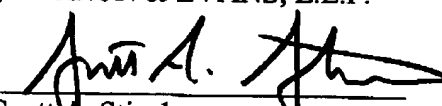If an additional extension of time is required, please consider this a petition therefor.

(Check and complete the next item, if applicable)

☐ An extension for ____ months has already been secured and the fee paid thereof of $____ is deducted from the total fee due for the total months of extension now requested. Extension fee due with this request $____.

OR

☒ (b) **Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.**

6. ☒ **If any additional fee for claims or extension of time is required, charge Account No. 23-3000.**

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: _____
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Enclosed:
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